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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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|-----------------|-------------|----------------------|---------------------|

08/306,650 09/14/94 KATZ

R 4646101N5

| WCD, S | EXAMINER |
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26M2/0701

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2603
DATE MAILED:

5
07/01/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

4646101N5 09/14/94

Office Action Summary

Application No.
08/306,650

Applicant(s)
Katz

Examiner
Stella Woo

Group Art Unit
2608



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-82 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-82 is/are rejected.

☐ Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

1. Claims 24-82 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 24, line 4; claim 38, line 4; claim 56, line 4; claim 63, line 4; claim 78, line 4, the phrase "may comprise" is vague and indefinite. Does the apparatus comprise a conventional telephone instrument or not?

In claim 45, lines 6-7, the phrase "for example, ANI signals" is vague and indefinite in that it is not clear as to whether or not "ANI signals" is a claim limitation. This phrase occurs in numerous claims and should be corrected appropriately. The same problem exists with the phrase "or the like" (note claim 56, line 2).

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 24-82 are rejected under the judicially created doctrine of double patenting over claims 1-34 of U. S. Patent No. 5,365,575 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, namely a telephonic-interface lottery control system with limited access, check digit verification, ANI and DNIS capability, call information recording.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

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matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 78-82 are rejected under the judicially created doctrine of double patenting over claims 1-41 of U. S. Patent No. 4,845,739 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, namely a telephonic-interface statistical analysis system which a lottery format including limited access, call information recording, check digit verification, ANI and DNIS capability, etc.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 24, 27, 28, 30-38, 41-44, 48-51, 55-67, 70, 73-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 1-12 of U.S. Patent No. 4,792,968. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S.P.N. 4,792,968 differs from the claims in that it does not specify lottery application. However, in col. 3, lines 9-13, it does suggest use of the system for public lotteries such that it would have been obvious to an artisan of ordinary skill to incorporate the system of U.S.P.N. for use as a lottery system.

6. Claims 25-26, 39-40, 45-47, 49, 52-54, 68-69, 72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 4,792,968 in view of U.S.P.N. 4,845,739. U.S.P.N. 4,792,968 differs from the claims in that it does not provide for ANI and DNIS capability. However, U.S.P.N. 4,845,739 shows the use of ANI and DNIS for automatically providing calling telephone information and to determine a selected format such that it would have been obvious to an artisan of ordinary skill to incorporate such ANI and DNIS capability within the system of U.S.P.N. 4,792,968 in order to more efficiently process incoming calls.

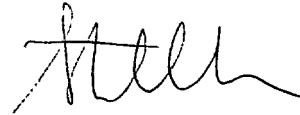
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed Stella Woo, whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Wednesday from 6:30 a.m. to 3:00 p.m.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 305-4700.



June 22, 1996

Stella Woo
Patent Examiner
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